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EXAMINER

SHAAWAT, MUSSA A

ART UNIT	PAPER NUMBER
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3627

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/781,698	Applicant(s) SUSSMAN, LESTER	
	Examiner MUSSA A. SHAAWAT	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-20 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 and 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is in response to amendment filed on 11/27/2007. Claims 14-17, 34, 36-39 and 43 have been amended. Claims 1-13 and 21-33 have been previously cancelled. Claims 14-20 and 34-44 are pending examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 14-20 and 34-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 and 36 recite "sending optionally said shopping ..." in part g of claims 14 and 36, the phrase "sending optionally" renders the claim indefinite. For the purpose of examination the phrase "*sending optionally*" will be interpreted as best understood by the examiner.

The dependent claims are rejected based on their dependency from rejected independent claims 14 and 36.

4. Claims 14 and 36 recite the limitation "said consumer's first computers; said consume first network infrastructure; and said additional shopping list" in part c), C(i) and C(vi) of claims 14 and 36. There is insufficient antecedent basis for this limitation in the claim.

The dependent claims are rejected based on their dependency from rejected independent claims 14 and 36.

5. In addition Claims 16 and 38 are rendered indefinite by the use of the trademarked term BLUETOOTH, and by reference to the "Bluetooth radio frequency standard." MPEP § 608.01(v) states, "the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade." Furthermore, the "Bluetooth radio frequency standard" is indefinite, because such a standard may be subject to change over time. Examiner suggests to change the use of the trademark "Bluetooth-enabled" in claims 16 and 38 to recite the following "the portable barcode ... an infrared link and Short range radio frequency link".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14-15, 17-19, 34-37, 39-41 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppert et al US Patent No. (5,424,524) referred to here in after as Ruppert in view of Petrovich et al, US PG Pub. No. (2003/0061113 A1) referred to hereinafter as Petrovich.

As per claim 14, Ruppert a method for creating a consumer's shopping list prior to entering a store, comprising *the steps of*:

(a) *Using a portable barcode scanner (see col.6 lines 1-18, fig. 5 108);*

(b) scanning a needed product barcode or a needed product coupon barcode using said portable barcode scanner (see col.5 lines 48-60, fig. 1);

(c) using one or more said consumer's first computers *comprising the sub-steps of*; receiving data from, and transmitting data to, said portable barcode scanner over said *consumer's* first network infrastructure (fig.3 block 85); storing said data as shopping list information under control of said product barcode or said product coupon barcode, in a memory means (fig.3 block 48); communicating with a second computer system, over a second network infrastructure to request and to receive information based on said product barcode or said product coupon barcode (fig.6 block 110); tracking frequency that said product barcode has been received from said portable barcode scanner over said first network infrastructure (see col.8 lines 50-53); providing a specific notification of repetitive scanned said product barcodes without repetitively needing a continuously scanned entry of said product barcodes (see col.2 lines 43-53); displaying a multiplicity of product barcodes or said product coupon barcodes, together with said additional shopping list information, on said consumer's first computer display (see fig. 1 display); indicating on said first computer display that said consumer has obtained said shopping list information in-hand from said consumer's first computer; adding automatically one or more repetitively scanned product barcodes to said shopping list on said tracking frequency (see fig.1 shows handheld device with shopping list); and indicating that said data transmitted to and said data received from said portable barcode scanner has been successfully sent and received;

(d) Transferring said scanned product barcode or said product coupon barcode to said consumer's first computer, over said first network infrastructure (see col.6 lines 1-18, fig. 5 108);

(e) Storing said transferred product barcode or said product coupon barcode in a shopping list database on said consumer's first computer, said shopping list database includes other product information, wherein said other product information includes: a product description, a product cost, and an indicator for a required quantity of said product (col.7 lines 13-20, fig.6 111);

(f) Obtaining in-hand said stored shopping list from said consumer's first computer in order to go to a first store and purchase products listed on said shopping list, said obtaining in-hand is selected from the group comprising: printing said stored shopping list on a printing device attached to said consumer's first computer (see col.12 lines 23-26), transferring said stored shopping list to a consumer's portable computer device, and using said portable barcode scanner (see fig.1, shopping list via portable scanner displayed in a handheld device); and

(g) Sending *optionally* said shopping list from said consumer's first computer to an optional second store connected to said second network infrastructure, said second store shipping products listed on said shopping list to said consumer, (col.6 lines 1-19); and

(h) Sending *optionally* said shopping list from said consumer's first computer to an optional second store connected to said second network infrastructure, said second

store making said products listed on said shopping list available to said consumer for pick up, (col.6 lines1-19 customer goes to check out).

Ruppert does not expressly teach wherein a customer is not required to shop in-store for said products.

Petrovich teaches wherein a customer is not required to shop in-store for said products, the customer can alternatively shop from home (see at least Para [0005], [0103]). It would have been obvious to one of ordinary skill in the art at the time the invention was to incorporate the teachings of Petrovich into the disclosure of Ruppert, for the convenience of the customer to do the shopping from home and have the products available for the customer for pick up or delivered to the customer's home. In addition Petrovich teaches wherein the shopping list can be generated wither in electronic form or hardcopy (i.e. printed via a printer attached to the computer) (see Para [0105], [0097]).

In addition, although Ruppert teaches wherein said other product information includes: a product description, a product cost, and an indicator for a required quantity of said product, Ruppert does not expressly teach wherein said product information includes a date and time which said barcode was scanned.

The examiner takes Official Notice that including the time and date of when the barcode was scanned is well known and old in the art at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Ruppert in view of Petrovic to include

the time and date of when the barcode was scanned, in order to create an efficient shopping list for the customer.

As per claim 15, Ruppert teaches a portable barcode scanner of claim 14, wherein said first network infrastructure is *a wireless link between said portable barcode scanner and said consumer's first computer* (see col.6 lines 1-7).

As per claim 17, Ruppert teaches a portable barcode scanner of claim 14, wherein said first network infrastructure is a wired link between said portable barcode scanner and said consumer's first computer (see col.6 1-10).

As per claim 18, Ruppert teaches a portable barcode scanner of claim 17, wherein said wired link is selected from the group comprising: an RS-232 link, a USB link, a parallel link and an IEEE 1394 link (see col.6 lines 1-5).

As per claim 19, Ruppert teaches a first computer of claim 14 is selected from the group comprising: a personal computer, a personal digital assistant, an Internet appliance, and a cell phone (see col.6 lines 1-5 and fig. 1).

As per claim 34, Ruppert teaches the portable computer device of claim 14 is selected from the group consisting: a personal digital assistant and a cell phone (see col.6 lines 1-5).

As per claim 35, Rupert teaches a shopping list of claim 14 is selected from the group comprising: beauty aids, books, clothing, computer hardware, computer software, computer supplies, drugs, footwear, groceries, gifts, health aids and music (see fig.1 shopping list).

As per claims 20 and 42, Ruppert et al disclose a system and method for creating a shopping list and purchasing items from the list comprising a personal digital assistant (Fig. 1) including a data system (40 and 43) for receiving product identification data from a UPC selected by a consumer for inquiry (see col. 6, lines 49-55), and a data communication system (85) for communicating data on a network infrastructure to a merchant computer system, wherein the merchant computer system includes a database that stores product descriptive information (see col. 6, lines 19-38). Ruppert et al further disclose a display (see Fig. 1) for displaying information associated with the product identifier. Ruppert et al further teach the steps of shopping in a store's aisles and delivering the items to the customers shopping basket (see Fig. 5, and columns 8 and 9).

Ruppert et al do not disclose a second network that interfaces with the portable interface unit through the Internet. However, Petrovich does teach second network that interfaces with the portable interface unit through the Internet (see at least Para [0060]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a personal computer as an intermediary with the invention of Ruppert et al to store information so that less memory is used in the personal digital assistant. Furthermore, use of the Internet is common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the Internet with the invention of Ruppert et al because the Internet is a convenient means of communication.

As per claim 16 and 38, Rupert discloses a wireless link selected from an infrared link (see col.6 lines 1-35, and col. 8 lines 53-66).

Ruppert et al do not teach the step of communicating through a radio frequency channel on a Bluetooth radio frequency standard. However, radio communication is common in the art, as is the Bluetooth standard. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a Bluetooth radio standard communication channel to allow for fast, wireless communication instead of cumbersome wired connections.

8. As per claims 36-37, 39-41, and 43-44, the limitations of claims 36-37, 39-41, and 43-44, are similar to the limitations of claims 14-15, 17-19, and 34-35, therefore the are rejected under the same rationale.

Response to Arguments

9. Applicant's arguments have been fully considered but are not persuasive. In particular applicant appears to argue, A) the use of official notice in the previous action with regard to the time and date of when the barcode was scanned is well known; B) Ruppert does not teach creating a shopping list without having necessarily to enter a store physically by scanning a product UPC barcode into a system that yields a usable in-hand shopping list (i.e. in electronic or print format).

In response to A) the applicant failed to specifically point out the supposed errors in the examiner's action, and to state why the notice fact is not considered to be common knowledge or well known in the art, therefore in view of the inadequate traversal, and in light of the requirements of 2144.03(c), the examiner notes that the well

known in the art ***statements of the previous Office Action are considered to be admitted prior art.*** See MPEP 2144.03(c) below.

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence **To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.** See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the examiner’s assertion of official notice would be inadequate. If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner’s assertion of official notice or applicant’s traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

In response to B) the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Examiner would like to direct applicant’s attention to the fact that Ruppert is not relied upon to teach the above mentioned feature rather Petrovich not Ruppert is relied upon to teach the above claimed feature. Petrovich teaches creating a shopping list at home by scanning various barcodes of items using the hand-held barcode scanner i.e. creating a shopping list without having to necessarily enter the store by scanning UPC barcode into a system that yields a usable in-hand shopping list (see at least Para 0005, 0103, and

0060-0063). Therefore Ruppert in view of Petrovich still meets the scope of the limitation as currently claimed.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat
Patent Examiner
February 6, 2008

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627